



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

29953-184828

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/630,982

Filed

July 31, 2003

First Named Inventor

James DUNMAN

Art Unit

1762

Examiner

Frederick John PARKER

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

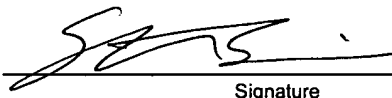
☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 42,159

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature

Stuart I. Smith

Typed or printed name

202-344-4000

Telephone number

February 21, 2006

Date

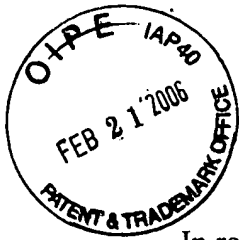
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

# 725583

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

James DUNMAN

Application No.: 10/630,982

Confirmation No.: 1857

Filed: July 31, 2003

For: METHOD FOR SHIELDING  
CONTAINERS ON A COATING  
LINE (AS AMENDED)

Art Unit: 1762

Examiner: Frederick J. PARKER

Atty. Docket No.: 29953-184828

Customer No.

**26694**

PATENT TRADEMARK OFFICE

**NOTICE OF APPEAL & PRE-APPEAL BRIEF REQUEST FOR REVIEW**

***Mail Stop After Final***

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

Sir:

In Response to the Office Action dated November 21, 2005, Applicant submits herewith a Notice of Appeal pursuant 37 C.F.R. § 41.31(a)(1), the claims having been twice rejected. Authorization is hereby given to charge the fee of \$500.00 set forth in 37 C.F.R. § 41.20(b)(1), as well as any additional fees necessary, and to credit any overpayments, to our deposit account no. 22-0261, referencing our docket no. 29953-184828. Applicant further submits herewith a Pre-Appeal Brief Request for Review in conjunction with the following Remarks.

## **REMARKS**

### **I. Introduction**

Claims 1-11 and 13-20 are pending. Applicant respectfully submits a Notice of Appeal pursuant 37 C.F.R. § 41.31(a)(1) and concurrently submits a Pre-Appeal Brief Request for Review supported by the following remarks. Reconsideration and prompt allowance of the application are respectfully requested.

### **II. Rejection of Claims 17-20 Under 35 U.S.C. § 112, first paragraph**

At pages 2-3 of the Office Action dated November 21, 2005, claims 17-20 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Applicant respectfully traverses this rejection for the reasons presented in the Request for Reconsideration filed October 6, 2005. *See* Req. for Reconsideration, pages 1-2. Applicant respectfully submits that at least FIG. 1 provides support for the recitation in claims 17-20 that “the *shields do not hold a threaded engagement portion* of a finish of the containers” (emphasis added). Accordingly, Applicant respectfully requests that the rejection of claims 17-20 under section 112, first paragraph, be withdrawn. Furthermore, because claims 17-20 have not been rejected as being anticipated by or unpatentable over any prior art, Applicant respectfully submits that these claims are in condition for allowance.

### **III. Rejection of Claims 1-4, 6, 8-12, 15, and 16 Under 35 U.S.C. § 103(a)**

At pages 3-5 of the Office Action, claims 1-4, 6, 8-12, 15, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,740,259 to Carl et al (“Carl”) in view of U.S. Patent No. 4,667,620 to White.<sup>1</sup> The rejection is respectfully traversed for at least the three reasons presented in the Request for Reconsideration filed October 6, 2005. *See* Req. for Reconsideration, pages 2-4. The Office Action fails to make a *prima facie* case of obviousness for the following reasons:

(1) *there is no suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Carl or to combine the reference teachings to meet the limitations of the claimed method (*see* Req.

---

<sup>1</sup> Applicant notes that claim 12 was canceled in the Amendment submitted May 23, 2005.

for Reconsideration, page 2 line 18 – page 3 line 17; Applicant's Amendment dated May 23, 2005, at page 9, line 15 – page 10, line 3);

(2) *the combination fails to teach all of the claim limitations* (see Req. for Reconsideration, page 3 line 18 – page 4 line 3; Applicant's Amendment dated May 23, 2005, at page 10, lines 3-6); and

(3) *the Office Action uses impermissible hindsight reconstruction based on Applicant's disclosure* (see Req. for Reconsideration, page 4, lines 4-11).

Accordingly, Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness and that claims 1-11 and 13-20 are allowable over the prior art.

**IV. Rejection of Claims 5, 7, 13 and 14 Under 35 U.S.C. § 103(a)**

The Office Action also rejects claims 5, 7, 13, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Carl in view of White, and further in view of "Admitted Prior Art". The rejection is respectfully traversed. Claims 5 and 7 depend from claim 1 and, therefore, are submitted as being allowable for at least the same reasons. Likewise, independent claim 13 includes all of the features recited in claim 1. Claim 14 depends from claim 13.

**V. Conclusion**

In view of the above, it is respectfully submitted that claims 1-11 and 13-20 are patentable over the prior art of record. Reconsideration and allowance of the present application is respectfully requested.

Respectfully submitted,

Date: February 21, 2006



Stuart I. Smith  
Registration No. 42,159  
Ryan M. Flandro  
Registration No. 58,094  
VENABLE LLP  
P.O. Box 34385  
Washington, D.C. 20043-9998  
Telephone: (202) 344-4000  
Telefax: (202) 344-8300  
Attorney/Representative for Applicant

SIS/RMF:trs  
DC2/725585v1